

Remarks

The Office Action mailed May 02, 2003, has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 6-10, 12-16, 18-26, and 28 are pending in the application. Claims 6 and 28 are allowed. Claims 7-10, 12-16 and 18-26 stand rejected. Claims 11, 17 and 27 stand objected to. Claims 1-5, 11, 17 and 27 have been canceled.

In accordance with 37 C.F.R. 1.136(a), a three month extension of time is submitted herewith to extend the due date of the response to the Office Action dated May 2, 2003, for the above-identified patent application from August 2, 2003 through and including November 2, 2003. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$950.00 to cover this extension of time request also is submitted herewith.

The objection to Claims 11, 17 and 27 is respectfully traversed.

Claims 11, 17 and 27 were objected to as being dependent upon a rejected base claim, but were indicated as being allowable if rewritten in independent form. Claim 11 has been canceled and the recitations from Claim 11 incorporated into Claim 7. Claim 17 has been canceled and the recitations from Claim 17 incorporated into Claim 12. Claim 27 has been canceled and the recitations from Claim 27 incorporated into Claim 18. Therefore, Applicants respectfully submit that Claims 7, 12, and 18 are in condition for allowance.

For the reasons set forth above, Applicants respectfully request that the objection to Claims 11, 17, and 27 be withdrawn.

The rejection of Claims 7, 8, 13, 14, 18-20 and 23 under 35 U.S.C. § 102(b) as being anticipated by Albright et al. (U.S. Pat. No. 4,330,726) is respectfully traversed.

Albright et al. describe a stator module (10) that includes an outer metallic cylindrical portion (12) and an inner non-metallic cylindrical portion (14). The inner portion includes

inwardly projecting teeth positioned to form slots (18) for stator windings (36). Notably, the teeth do not include at least one embedded conductor.

Claim 7 recites “a method for fabricating a stator with non-magnetic teeth, the stator including a non-magnetic tooth back portion including a plurality of non-magnetic teeth and a back portion, the non-magnetic teeth unitary with each other and with the back portion, said method comprises the steps of fabricating a back iron...and attaching the non-magnetic tooth back portion to the back iron, wherein the non-magnetic tooth back portion includes at least one embedded conductor.”

Albright et al. do not describe nor suggest a method for fabricating a stator with non-magnetic teeth, the stator including a non-magnetic tooth back portion including a plurality of non-magnetic teeth and a back portion, the non-magnetic teeth unitary with each other and with the back portion, including the steps of fabricating a back iron and attaching the non-magnetic tooth back portion to the back iron wherein the non-magnetic tooth back portion includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth. For the reasons set forth above, Claim 7 is submitted to be patentable over Albright et al.

Claim 8 depends from independent Claim 7. When the recitations of Claim 8 are considered in combination with the recitations of Claim 7, Applicants submit that dependent Claim 8 is likewise patentable over Albright et al.

Claim 12 recites a stator including “a back iron...and a plurality of non-magnetic teeth unitary with each other and with a back portion, said back portion mounted on said back iron, wherein at least one said non-magnetic tooth comprises at least one embedded conductor.”

Albright et al. do not describe nor suggest a stator including a back iron, and a plurality of non-magnetic teeth unitary with each other and with a back portion, wherein at least one said non-magnetic tooth comprises at least one embedded conductor. Rather,

Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth. For the reasons set forth above, Claim 12 is submitted to be patentable over Albright et al.

Claims 13 and 15 depend, directly or indirectly, from independent Claim 12. When the recitations of Claims 13 and 14 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13 and 14 likewise are patentable over Albright et al.

Claim 18 recites a dynamoelectric machine including “a stator... comprising a back iron and a plurality of non-magnetic teeth unitary each other and with a back portion, said back portion mounted to said back iron, wherein at least one of said non-magnetic teeth comprises at least one embedded conductor”.

Albright et al. do not describe nor suggest a stator including a back iron and a plurality of non-magnetic teeth unitary with each other and with a back portion, the back portion mounted to the back iron, wherein at least one of the non-magnetic teeth includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth. For the reasons set forth above, Claim 18 is submitted to be patentable over Albright et al.

Claims 19, 20, and 23 depend from independent Claim 18. When the recitations of Claims 19, 20, and 23 are considered in combination with the recitations of Claim 18, Applicants submit that dependent Claims 19, 20, and 23 likewise are patentable over Albright et al.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 7, 8, 13, 14, 18-20 and 23 be withdrawn.

The rejection of Claims 9, 15, 21, 22, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Albright et al. (U.S. Pat. No. 4,330,726) in view of Chari et al. (U.S. Pat. No. 4,278,905) is respectfully traversed.

Albright et al. is described above. Chari et al. describe a plurality of stator bars (36) positioned in an air-gap between a yoke (32) and a rotor (6) by a plurality of non-conductive, glass-reinforced-fiber, supporting teeth (51). The teeth are interspaced between the stator bars and are rigidly attached to the yoke. Notably, the teeth do not include at least one embedded conductor.

Claim 9 depends from Claim 7, which recites “a method for fabricating a stator with non-magnetic teeth, the stator including a non-magnetic tooth back portion including a plurality of non-magnetic teeth and a back portion, the non-magnetic teeth unitary with each other and with the back portion, said method comprises the steps of fabricating a back iron...and attaching the non-magnetic tooth back portion to the back iron, wherein the non-magnetic tooth back portion includes at least one embedded conductor.”

Neither Albright et al. nor Chari et al., considered alone or in combination, describe or suggest a method for fabricating a stator with non-magnetic teeth, the stator including a non-magnetic tooth back portion including a plurality of non-magnetic teeth and a back portion, the non-magnetic teeth unitary with each other and with the back portion, including the steps of fabricating a back iron and attaching the non-magnetic tooth back portion to the back iron wherein the non-magnetic tooth back portion includes at least one embedded conductor. Specifically, neither Albright et al. nor Chari et al. describe or suggest attaching the non-magnetic tooth back portion to the back iron, wherein the non-magnetic tooth back portion includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth, and Chari et al. describes a plurality of non-conductive, glass-reinforced-fiber, supporting teeth. For the reasons set forth above, Claim 7 is submitted to be patentable over Albright et al. in view of Chari et al.

Claim 9 depends indirectly from independent Claim 7. When the recitations of Claim 9 are considered in combination with the recitations of Claim 7, Applicants submit that dependent Claim 9 likewise is patentable over Albright et al. in view of Chari et al.

Claim 15 depends from Claim 12, which recites a stator including “a back iron...and a plurality of non-magnetic teeth unitary with each other and with a back portion, said back portion mounted on said back iron, wherein at least one said non-magnetic tooth comprises at least one embedded conductor.”

Neither Albright et al. nor Chari et al., considered alone or in combination, describe or suggest a stator including a back iron, and a plurality of non-magnetic teeth unitary with each other and with a back portion, wherein at least one said non-magnetic tooth comprises at least one embedded conductor. Specifically, neither Albright et al. nor Chari et al. describe at least one non-magnetic tooth that includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth, and Chari et al. describes a plurality of non-conductive, glass-reinforced-fiber, supporting teeth. For the reasons set forth above, Claim 12 is submitted to be patentable over Albright et al. in view of Chari et al.

Claim 15 depends directly from independent Claim 12. When the recitations of Claim 16 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claim 16 likewise is patentable over Albright et al. in view of Chari et al.

Claims 21, 22, and 24 depend from Claim 18, which recites a dynamoelectric machine including “a stator... comprising a back iron and a plurality of non-magnetic teeth unitary each other and with a back portion, said back portion mounted to said back iron, wherein at least one of said non-magnetic teeth comprises at least one embedded conductor”.

Neither Albright et al. nor Chari et al., considered alone or in combination, describe or suggest a stator including a back iron and a plurality of non-magnetic teeth unitary with each other and with a back portion, the back portion mounted to the back iron, wherein at least one of the non-magnetic teeth includes at least one embedded conductor. Specifically, neither Albright et al. nor Chari et al. describe at least one non-magnetic tooth that includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth, and Chari et al.

describes a plurality of non-conductive, glass-reinforced-fiber, supporting teeth. For the reasons set forth above, Claim 18 is submitted to be patentable over Albright et al. in view of Chari et al.

Claims 21, 22, and 24 depend, directly or indirectly, from independent Claim 18. When the recitations of Claim 26 are considered in combination with the recitations of Claim 18, Applicants submit that dependent Claim 26 likewise is patentable over Albright et al. in view of Chari et al.

In addition, applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Albright et al. according to the teachings of Chari et al. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Albright et al. nor Chari et al., describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Albright et al. is cited for its teaching of a stator that includes inwardly projecting teeth, and Chari et al. is cited for its teaching of a stator bar that includes a plurality of teeth. Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 9, 15, 21, 22, and 24 be withdrawn.

Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Albright et al. with Chari et al. because there is no motivation to combine the references suggested in

the art. Rather, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Specifically, only the conclusory statement "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to the method for fabricating a stator as taught by Albright et al. and to provide the back section with a key installed in the slots as taught by Chari et al. for the purpose of installing and fit separately prefabricated non-magnetic tooth back portion and the back iron, and using the stator with well known in the art superconducting armature" suggests combining the references.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Moreover, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present

invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

Applicants respectfully submit that absent the teaching of the present specification, neither Albright et al. nor Chari et al., considered alone or in combination, describe nor suggest the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. As such, the rejection appears to be impermissible hindsight reconstruction of the claimed invention using the present specification as a template to motivate a modification based on Albright et al. and Chari et al. to render the claimed invention obvious.

For the reasons set forth above, Applicants respectfully request that the Section 103(a) rejection of Claims 9, 15, 21, 22, and 24 be withdrawn.

The rejection of Claims 10, 16, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Albright et al. (U.S. Pat. No. 4,330,726) in view of Tesar (U.S. Pat. No. 5,355,743) is respectfully traversed.

Albright et al. is described above. Tesar describes a plurality of planet gears (14) that include two sets of teeth (14a and 14b). The gears may be made of metal teeth on a ring attached to a carbon fiber disc structure. Notably, the teeth do not include at least one embedded conductor.

Claim 10 depends from Claim 7, which recites “a method for fabricating a stator with non-magnetic teeth, the stator including a non-magnetic tooth back portion including a plurality of non-magnetic teeth and a back portion, the non-magnetic teeth unitary with each other and with the back portion, said method comprises the steps of fabricating a back iron...and attaching the non-magnetic tooth back portion to the back iron, wherein the non-magnetic tooth back portion includes at least one embedded conductor.”

Neither Albright et al. nor Tesar, considered alone or in combination, describe or suggest a method for fabricating a stator with non-magnetic teeth, the stator including a non-

magnetic tooth back portion including a plurality of non-magnetic teeth and a back portion, the non-magnetic teeth unitary with each other and with the back portion, including the steps of fabricating a back iron and attaching the non-magnetic tooth back portion to the back iron wherein the non-magnetic tooth back portion includes at least one embedded conductor. Specifically, neither Albright et al. nor Tesar describe or suggest attaching the non-magnetic tooth back portion to the back iron, wherein the non-magnetic tooth back portion includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth, and Tesar describes a plurality of gears that include two sets of teeth. For the reasons set forth above, Claim 7 is submitted to be patentable over Albright et al. in view of Tesar.

Claim 10 depends directly from independent Claim 7. When the recitations of Claim 10 are considered in combination with the recitations of Claim 7, Applicants submit that dependent Claim 10 likewise is patentable over Albright et al. in view of Tesar.

Claim 16 depends from Claim 12, which recites a stator including “a back iron...and a plurality of non-magnetic teeth unitary with each other and with a back portion, said back portion mounted on said back iron, wherein at least one said non-magnetic tooth comprises at least one embedded conductor.”

Neither Albright et al. nor Tesar, considered alone or in combination, describe or suggest a stator including a back iron, and a plurality of non-magnetic teeth unitary with each other and with a back portion, wherein at least one said non-magnetic tooth comprises at least one embedded conductor. Specifically, neither Albright et al. nor Tesar describe at least one non-magnetic tooth that includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth, and Tesar describes a plurality of gears that include two sets of teeth. For the reasons set forth above, Claim 12 is submitted to be patentable over Albright et al. in view of Tesar.

Claim 16 depends directly from independent Claim 12. When the recitations of Claim 16 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claim 16 likewise is patentable over Albright et al. in view of Tesar.

Claim 26 depends from Claim 18, which recites a dynamoelectric machine including “a stator... comprising a back iron and a plurality of non-magnetic teeth unitary each other and with a back portion, said back portion mounted to said back iron, wherein at least one of said non-magnetic teeth comprises at least one embedded conductor”.

Neither Albright et al. nor Tesar, considered alone or in combination, describe or suggest a stator including a back iron and a plurality of non-magnetic teeth unitary with each other and with a back portion, the back portion mounted to the back iron, wherein at least one of the non-magnetic teeth includes at least one embedded conductor. Specifically, neither Albright et al. nor Tesar. describe at least one non-magnetic tooth that includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth, and Tesar describes a plurality of gears that include two sets of teeth. For the reasons set forth above, Claim 12 is submitted to be patentable over Albright et al. in view of Tesar.

Claim 26 depends directly from independent Claim 18. When the recitations of Claim 26 are considered in combination with the recitations of Claim 18, Applicants submit that dependent Claim 26 likewise is patentable over Albright et al. in view of Tesar.

In addition, applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Albright et al. according to the teachings of Chari et al. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Albright et al. nor Tesar, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected

from multiple patents in an attempt to arrive at the claimed invention. Specifically, Albright et al. is cited for its teaching of a stator that includes inwardly projecting teeth, and Tesar is cited for its teaching of a plurality of planet gears that include two sets of teeth. Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 10, 16, and 26 be withdrawn.

Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Albright et al. with Tesar because there is no motivation to combine the references suggested in the art. Rather, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Specifically, only the conclusory statement "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to design the method as disclosed by Albright et al. and to provide the non-magnetic teeth comprising the well know in the art high carbon fiber material as taught by Tesar for the purpose of reducing weight of the rotating parts while simultaneously providing a high structural strength characteristics since it has been held to be with the general skill of a worker in the art to select a known material on the basis of it suitability for the intended use as a matter of obvious design choice" suggests combining the references.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Moreover, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

Applicants respectfully submit that absent the teaching of the present specification, neither Albright et al. nor Tesar, considered alone or in combination, describe nor suggest the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. As such, the rejection appears to be impermissible hindsight reconstruction of the claimed invention using the present specification as a template to motivate a modification based on Albright et al. and Tesar to render the claimed invention obvious.

For the reasons set forth above, Applicants respectfully request that the rejection of Claims 10, 16 and 26 under Section 103(a) as being unpatentable over Albright et al. in view of Tesar be withdrawn.

The rejection of Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Albright et al. (U.S. Pat. No. 4,330,726) in view of Everton (U.S. Pat. No. 5,670,838) is respectfully traversed.

Albright et al. is described above. Everton describes a stator assembly (3) comprising an armature winding having a series of angularly spaced and axially elongate teeth (9) interposed between adjacent windings (8). The teeth have, in radial cross section, a flared or divergent head portion (13) adjacent to a back member (10) and a similarly divergent foot portion (14) adjacent to a rotor assembly (4). The head portions of the teeth are very slightly spaced from the back member so as to create a magnetic back gap between them. Further, Everton describes that the back gap is filled with resin to bond the teeth to the back member and the resin serves as a magnetic reluctance. Notably, the teeth do not include at least one embedded conductor

Neither Albright et al. nor Everton, considered alone or in combination, describe or suggest the claimed combination. Specifically Claim 25 depends indirectly from Claim 18 which recites a dynamoelectric machine including “a stator... comprising a back iron and a plurality of non-magnetic teeth unitary each other and with a back portion, said back portion mounted to said back iron, wherein at least one of said non-magnetic teeth comprises at least one conductor”.

Neither Albright et al. nor Everton, considered alone or in combination, describe or suggest a stator including a back iron and a plurality of non-magnetic teeth unitary with each other and with a back portion, the back portion mounted to the back iron, wherein at least one of the non-magnetic teeth includes at least one embedded conductor. Specifically, neither Albright et al. nor Everton describe at least one non-magnetic tooth that includes at least one embedded conductor. Rather, Albright et al. describe a stator module that includes an inner non-metallic cylindrical portion with inwardly projecting teeth, and Everton describes a series of angularly spaced and axially elongate teeth bonded to a back member. For the reasons set forth above, Claim 18 is submitted to be patentable over Albright et al. in view of Everton.

Claim 25 depends indirectly from Claim 18. When the recitations of Claim 25 are considered in combination with the recitations of Claim 18, Applicants submit that dependent Claim 25 likewise is patentable over Albright et al. in view of Everton.

In addition, applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Albright et al. according to the teachings of Everton. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Albright et al. nor Everton, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Albright et al. is cited for its teaching of a stator that includes inwardly projecting teeth, and Everton is cited for its teaching of a stator assembly that includes a series of teeth. Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claim 25 be withdrawn.

Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Albright et al. with Everton because there is no motivation to combine the references suggested in the art. Rather, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Specifically, only the conclusory statement "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to design the machine as taught by Albright et al. and to provide the teeth being attached to the back iron with adhesive as taught by Everton for the purpose of providing a magnetic reluctance" suggests combining the references.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather,

there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Moreover, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

Applicants respectfully submit that absent the teaching of the present specification, neither Albright et al. nor Everton, considered alone or in combination, describe nor suggest the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. As such, the rejection appears to be impermissible hindsight reconstruction of the claimed invention using the present specification as a template to motivate a modification based on Albright et al. and Everton to render the claimed invention obvious.

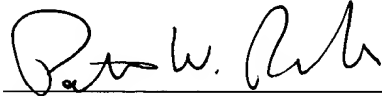
For the reasons set forth above, Applicants respectfully request that the Section 103(a) rejection of Claim 25 be withdrawn.

Express Mail No.: EL977935945US

**GEKAN-3214
PATENT**

In view of the foregoing remarks, this application is believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Patrick W. Rasche", written over a horizontal line.

Patrick W. Rasche
Registration No. 37,916
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070